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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/610,695	07/02/2003	Isao Yako	041465-5193	1829
55694 7590 09/11/2007 DRINKER BIDDLE & REATH (DC) 1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209			EXAMINER ZHAO, DAQUAN	
			ART UNIT 2621	PAPER NUMBER
			MAIL DATE 09/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/610,695	<b>Applicant(s)</b> YAKO, ISAO	
	<b>Examiner</b> Daquan Zhao	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

### **Claim Status**

2. Claim 4 is canceled; claims 1, 12 and 13 are amended; and other claims are original.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 12 is rejected under 35 U.S.C. 101 because this claim directed to non-statutory subject matter. In contrast, a claimed computer- readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5-8, 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Okada et al (US 6,148,140).

In regards to claim 1, Okada et al teach an apparatus for reproducing data comprising:

- a reproduction device for receiving a data constellation, which includes content data and control data for controlling reproduction of said content data, and reproducing said content data based on said control data (e.g. figure 12A, column 26, lines 5-9 and lines 47-55, the audio data corresponds to the content data and the audio gap start time, the audio gap length and the audio gap location in the RTRW management information corresponds to the control data).
- a detection device for detecting, based on no existence of the control data for designating the content data to be reproduced next, or no existence of the content data to be reproduced next or a non-designated state thereof (e.g. the audio gap corresponds to no existence of the content data to be reproduced next), whether or not the reproduction of said content data by means of said reproduction

device is to be halted based on said control data (e.g. column 30, lines 19-33, column 31, lines 3-10, and column 33, lines 4-10, halting the audio decoder based on the location of the audio gap, wherein the, audio gap start time, audio gap length and the audio gap location information in the management information shown in figure 12A provides the location of the audio gap) and

- a subsequent processing-execution device for executing a subsequent processing as previously set, when said detection device obtains detection results that the reproduction of said content data by means of said reproduction device is to be halted (e.g. column 31, lines 45-48, continue reproducing the audio after the audio gap).

Claims 12 and 13 are rejected for the same reasons as discussed in claim 1 above.

**Regarding claim 2,** Okada et al teach a subsequent processing-setting device for setting contents of said subsequent processing, which is to be executed by means of said subsequent processing-execution device, through input of a user's instruction (e.g. column 79, lines 60-67).

**Regarding claim 3,** Okada et al teach detection device detects whether the control data including a command to halt the reproduction of said content data by means of said reproduction device have been used or not (e.g. column 31, line 66-column 32, line 8).

**Regarding claim 5**, Okada et al teach subsequent processing-execution device reproduces, as said subsequent processing, a menu for said content data (e.g. figure 42 shows a menu).

**Regarding claim 6**, Okada et al teach subsequent processing-execution device reproduces, as said subsequent processing, content data designated by the user (e.g. column 59, lines 39-47).

**Regarding claim 7**, Okada et al teach subsequent processing-execution device outputs, as said subsequent processing, a message for prompting the user to input a predetermined instruction (e.g. column 59, lines 39-47, and figure 42, a display message for user to input the play instruction).

**Regarding claim 8**, Okada et al teach reproduction device comprises a receiving unit for receiving a recording medium in which said data constellation has been recorded, and a reading unit for reading said data constellation from said recording medium to reproduce said content data based on said control data; and said subsequent processing-execution device unloads, as said subsequent processing, said recording medium from said receiving unit (e.g. column 59, line 66- column 60, line 5, column 60, lines 50-64).

**Regarding claim 10**, Okada et al teach reproduction device reads the data constellation from the recording medium in which said data constellation has been recorded, and reproduce said content data based on said control data included in the data constellation as read out (column 61, lines 45-55); and

said subsequent processing-execution device conducts, as said subsequent processing, a reproduction termination processing for the content data recorded in said recording medium and then, conducts a reproduction preparation processing for a next reproduction start (e.g. column 33, line 61- column 34, line 11).

**Regarding claim 11**, Okada et al teach subsequent processing-execution device offers, as said subsequent processing, a plurality of processing to the user and outputs a message for prompting the user to select any one of said plurality of processing (e.g. figure 42, "play", "record", "mark"...etc).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al (US 6,148,140) as applied to claims 1-3, 5-8, 10-13 above, and further in view of Official Notice.

**Regarding to claim 9**, Okada et al teach reproduction device comprises a reading unit for reading data constellation from the recording medium to reproduce content data based on control data (column 61, lines 45-55).

However, Okada et al fail to specify plurality of recording media and replacing the recording medium with another recording medium. The examiner takes official notice for plurality of recording media and replacing the recording medium with another recording medium since that is well known in the art. It would have been obvious for one ordinary skill in the art at the time the invention was made to have plurality of recording media and replacing one recording medium with another recording medium to increase the storage capacity.



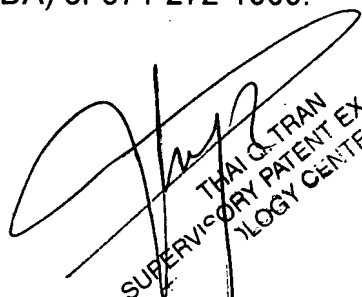
Art Unit: 2621

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daquan Zhao whose telephone number is (571) 270-1119. The examiner can normally be reached on M-Fri. 7:30 -5, alt Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai Q, can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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